

REMARKS

The Examiner has provided responses A-G to a subset of Applicant's arguments filed on August 17, 2007. These responses are addressed below. In view of the following remarks, Applicant requests reconsideration and withdrawal of the section 102 rejection of all claims.

(A)

On page 7 of the final office action, the Examiner suggests that claim 1 lacks the limitation of delivering content files for use by a client in drawing objects.

Contrary to the Examiner's statement, such a limitation is already in claim 1. Specifically, Applicant draws attention to the recitation of "content update" in claim 1 paragraph (a)¹ and to claim 1's preamble.²

(B)

Applicant urged that *Poulin*'s data set could not be regarded as a "content update" because it contained state information about clients, and not content.

The Examiner's position appears to be that the *Poulin* data sets contain information that is sent to a client. The nature of this information is, in the Examiner's view, unimportant. All that matters to the Examiner is that some sort of information is sent to a client. This act of sending information from a data set to a client is, in the Examiner's opinion, the same as "transmitting, to a client, a content update."

Applicant submits that it is improper to ignore the nature of the information. In particular, it is improper to regard a "content update" as being the same as any update.

The Examiner construes "content update" so broadly that it encompasses transmitting almost anything to a client. In fact, given the Examiner's construction of "content update," it is difficult to imagine *any* update that is *not* a content update.

¹ "Hosting, for transmission, a content update."

² "A method for efficiently transmitting to a client, a content update."

Under the Examiner's expansive definition of "content update," there is no difference whatsoever between a "content update" and just an "update." In the Examiner's proposed definition *any update whatsoever* is a "content update."

Applicant recognizes that the Examiner is entitled to use the broadest reasonable interpretation of a claim. However, the interpretation must still be *reasonable*. A definition in which a species ("content update") means the same thing as its genus ("update") is unreasonable on its face.

Moreover, the "broadest reasonable interpretation" is applied to the *claim*, not the individual terms in a claim. According to the Court in *Phillips v. AWH*, the PTO "determines the scope of claims...not solely on the basis of the claim language, but upon giving the claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'"³

The Examiner's interpretation of "content update" as including "any information transmitted to a client" is manifestly unreasonable "in light of the specification as it would be interpreted by one of ordinary skill in the art."⁴

Accordingly, Applicant requests reconsideration and withdrawal of the section 102 rejection of claim 1.

(C)

The Examiner seems to suggest that when *Poulin* transmits *full* information, it is transmitting "high quality data." By implication, the Examiner suggests that when *Poulin* transmits only a *subset* of the information, it is somehow transmitting "low-quality data."

Reduced to its essentials, the Examiner's position appears to be that:

1. When *Poulin* transmits a complete data set, it transmits "high quality" data; and

³ *Phillips v. AWH*, 415 F.3d 1303 (Fed. Cir. 2005).

⁴ *Id.*

2. When *Poulin* transmits only a subset of the data set, it transmits “low quality” data.

Conceptually, this makes no sense at all. Whether or not an entire data set is transmitted affects the *quantity* of data, not its “*quality*.” If the data set is high-quality to begin with, then *any* subset of the data must be high-quality.

By way of analogy, if a pie tastes good (i.e. is high quality), *every* slice (i.e. subset) tastes just as good. A slice of pie does not decline in “*quality*” simply because it is a mere “subset” of the entire pie.

Moreover, the Examiner’s proposition, that a subset of a high-quality superset is somehow low-quality, is mathematically unsound. A subset of a set *can include the set itself*. Therefore, the idea that transmitting a set results in high-quality data but transmitting a mere subset results in low-quality data leads to a contradiction in the case where the subset is the set itself.

Accordingly, Applicant submits that *Poulin* makes no distinction between high quality data and low quality data. Therefore, *Poulin* fails to teach claim 1’s limitation of “identifying a subset of the plurality of data files as high-quality data files.”

In view of *Poulin*’s failure to teach any distinction between high and low quality data, Applicant requests reconsideration and withdrawal of the section 102 rejection of claim 1.

(D)

With regard to claims 6 and 13, the Examiner suggests that according to *Poulin* [0025], when a file is sent to the client, it inherently replaces (i.e. “removes”) an existing file.

The Examiner’s argument thus relies on inherency. However, an argument based on inherency requires that the allegedly inherent feature be a necessary result of what the reference teaches.

MPEP 2112 (IV), which discusses the law of inherency, draws attention to the Federal Circuit's statement that

"[t]o establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." ... "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."⁵

The general rule of inherency is that if a feature *necessarily* follows from what has been expressly disclosed, then that feature is inherently disclosed. However, if the absence of the feature is also consistent with the express disclosure, then the feature is *not* inherently disclosed.

This rule is articulated in MPEP 2112:

"[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic"

as well as by the Board of Appeals:

"In relying upon the theory of inherency , the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art."⁶

and again, nine years later, by the Federal Circuit:

"To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed.Cir.1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 948 F.2d 1264, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A.1981))."⁷

⁵ *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999).

⁶ *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) [emphasis in original].

⁷ *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

In the present case, the claimed feature does not *necessarily* follow from *Poulin*'s disclosure. It is quite possible to save an existing file in the course of an update. In fact, paragraph 54 of Applicant's published application specifically refers to this possibility:

"Alternatively, the client may maintain older versions of the files in storage..."⁸

Since *Poulin* is consistent with both the presence or absence of claim 6's additional limitation, it cannot be regarded as implicitly teaching claim 6's additional limitation of "removing the high-quality data files from the content update."

(E)

With regard to claims 3, 10, and 16 the Examiner states that *Poulin* [0010] teaches the "data quality function" because the *Poulin* data sets have information about each client.

The Examiner's position appears to be that a data set having information about each client is a "high quality" data set. But even if this were true, it would not mean that there existed a "data quality function" that identified high-quality data files.

Applicant requests that the Examiner quote verbatim the specific text in paragraph 10 that allegedly reveals "using a data quality function to identify a subset of the plurality of data files contained in the content update as high-quality data files."

If the Examiner cannot quote verbatim from *Poulin* [0010] the text that allegedly teaches the additional limitations of claims 3, 10, and 16, then the section 102 rejection of claim 3 is improper and should be withdrawn.

(F)

With regard to claims 5 and 12, the Examiner draws attention to *Poulin* [0046], which teaches that volumes represent geographic regions having different sizes.

The sizes referred to in *Poulin* [0046] are sizes of *geographic regions*. They are not sizes of *data files*.

⁸ Dyl, US 2005/0026692, paragraph 54.

Claim 5 recites a "data quality that is a function of the sizes of the plurality of *data files*.
Claim 5 does not refer to the sizes of geographic regions.

Geographic regions are obviously *not* data files.

Accordingly, *Poulin* fails to teach the additional limitation of claims 5 and 12.

(G)

With regard to claims 7 and 14, the Examiner makes the conclusory assertion that "[s]uch arguments were addressed in the above points."

In discussing other claims, the Examiner has suggested that "high-quality" data files are those that include information about all clients, whereas "low-quality" data files are those that include information about a subset of the clients.

The foregoing suggestion, even if correct, fails to establish that *Poulin* teaches "determining that [a] received [client connection] request includes a bit value indicating high-quality data files should be transferred."

CONCLUSION

No fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, or if a refund is forthcoming, please adjust our Deposit Account No. 06-1050, referencing Attorney Docket No. 19815-014001.

Respectfully submitted,

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